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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/126,945

Applicant(s)

Libermann et al.

Examiner

Scott D. Priebe, Ph.D.

Group Art Unit

1632



X Responsive to communication(s) filed on Apr 5, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) 23 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

X Claims 1-22 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some* ☐ None ☐ of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1632

DETAILED ACTION

The amendment filed 4/5/99 has been entered in part. The amendment directed to page 104, line 6 could not be entered as instructed as "No: ." does not appear.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 17 (second part), and 21, drawn to human polynucleotides and method using same in treatment, classified in class 536, subclass 23.5; class 435, subclasses 320.1 and 325; class 514, subclass 44.
- II. Claims 11-12 and 14-16, drawn to polypeptides and method for making same from cultured cells, classified in class 435, subclass 70.1; class 530, subclass 350. (Note that the claim does not require that the polypeptide be expressed from recombinant DNA.)
- III. Claims 13 and 19, drawn to an antibody and method of using same to identify a polypeptide, classified in class 530, subclass 387.1; class 435, subclass 7.21
- IV. Claim 17 (first part), drawn to a method of treatment with a protein, classified in class 514, subclass 2.
- V. Claim 18, drawn to a method for detecting mutation in polynucleotide, classified in class 435, subclass 6.

Art Unit: 1632

VI. Claim 20, drawn to a method for identifying a ligand of a polypeptide, classified in class 435, subclass 7.1.

VII. Claim 22, drawn to a method for identifying a biological activity, classified in class 435, subclass 455.

Claim 23, draw to a product-by-process, is withdrawn from consideration because claim 22, from which claim 23 depends, is not a method of making a product, nor does claim 22 provide antecedent basis for "The product" in claim 23. Consequently, the subject matter of claim 23 could not be determined.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different products or methods, restriction is deemed to be proper because these products or methods appear to constitute patentably distinct inventions for the following reasons: Each of the methods of Groups I-VII require different products for their practice, involve different process steps and have different goals or outcomes.

The polynucleotides of Group I are not used in the methods of Groups II-VIII. The polypeptides of Group II are not used in the methods of Groups I and V. The antibodies of Group III are not used in the methods of Groups I, II, and IV-VII.

Inventions II and inventions III, IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

Art Unit: 1632

product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group II can be used in any one of the methods of inventions III, IV and VI.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification; the search required for each group is not required for the other groups; and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Eric Steffe on 10/5/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1632

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Scott D. Priebe, Ph.D.
Primary Examiner
Technology Center 1600
Art Unit 1632